



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kazuaki WATANABE, et al

Application No.: 10/001,256

Appeal No. 2005-1629

Group No.: 1755

Filed: November 2, 2001

Examiner.: Callie E. Shosho

For: INK COMPOSITION FOR INK JET PRINTER

Attorney Docket No.: U 013698-2

BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

REQUEST FOR REHEARING

Appellants respectfully request rehearing under 37 CFR 41.52 of the Decision on
Appeal mailed 30 March 2006 (hereinafter "the Decision"). In accordance with the provisions

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

*(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☒ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.
O. Box 1450, Alexandria, VA 22313-1450.
37 C.F.R. 1.8(a)

37 C.F.R. 1.10*

- ☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Address"
Mailing Label No. _____ (mandatory)

TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office. to (571)-273-8300

Date: May 25, 2006

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

of 37 CFR 41.52, Appellants state with particularity the following points believed to have been misapprehended or overlooked by the Board.

I. Sano Does Not Suggest that the Claimed Penetrant is Useful for Other Ink Compositions

In deciding that the cited references set forth a *prima facie* case of obviousness, the Board considers the secondary reference, Sano, to provide motivation for using Sano's preferred penetrating agent in the ink compositions of the primary references. See, Decision at page 7, line 19 to page 8, line 11 ("Accordingly, we determine that one of ordinary skill in this art would have been motivated to use any well known penetrating agent, as taught by Sano, in place of the common penetrant [disclosed by the primary reference]"). The Board has respectfully misapprehended the teachings in Sano, which do **not** suggest that the subject penetrating agent is useful for other ink compositions, but rather are specifically directed to the usefulness of the subject penetrating agent in the specific (alginate-containing) ink compositions described in Sano. In this respect, Appellants respectfully call the Board's attention to the following passages in Sano:

"In other words, although a phenomenon such as lateral development or vertical penetration of the ink composition can be **normally** inhibited by the use of a penetrant, the ink composition **of the present invention** can do by the alginate incorporated therein, making it possible to enhance the print quality as mentioned above." Sano at column 4, lines 24-29.

(Emphasis added.) ;

“An ink composition for ink jet recording has heretofore normally comprised a surface active agent in a concentration of not less than critical micelle concentration (cmc) to attain an enhanced penetrating power that lessens color bleeding. However, **in the present invention**, it is not necessary that the penetrating power be extremely raised as the conventional ink composition. The ink composition **of the present invention** comprises as the foregoing penetrant (D) one or more penetrants selected from the group consisting of. . .” Sano at column 7, lines 21-36. (Emphasis added.); and

“In order to provide the ink compositions **of the present invention** with a necessary penetrating capacity, the foregoing surface active [I], monohydric alcohol [II] and polyhydric alcohol derivative [III] may be used, singly or in combination, in the respective concentration.” Sano at column 8, lines 62 to 66. (Emphasis added.).

In short, Sano teaches that the described penetrants are useful for the Sano ink compositions (“the present invention”) and does **not** purport to teach that the claimed penetrating agent is useful for inks other than those (alginate-containing) inks described therein. Accordingly, it is respectfully submitted that Sano **cannot** provide a motivation to use the claimed penetrating agent in the ink compositions of the primary references. This is *a fortiori* true when Sano is considered in connection with the teachings in Anton (discussed next), which make clear that all surfactants/penetrating agents are not suitable for all ink compositions.

II. Anton Teaches that Selection of the Surfactant Requires Knowledge of the Effects

The Board has acknowledged the teaching in Anton that “the type of surfactants and the amounts used need to be carefully selected to avoid pigment dispersion destabilization or to negate the benefits of the present inks”, but has respectfully focused only on the part of this teaching that relates to **the amount** of surfactant while overlooking the teaching as to the necessity carefully to select **the type** of surfactant. See, Decision at page 8, lines 5-10 (“It would have been equally obvious to use any of the well known penetrants taught by Sano in the ink composition of Anton which does not contain alginates, especially in view of Anton’s teaching regarding the type and *amount* of surfactant, since Sano also teaches the controlled addition of surfactants/penetrants depending on the *amount*.”) (Emphasis in original.)

In light of Anton’s teaching that the type of surfactant must be carefully selected to avoid negative effects, there could have been no motivation, absent the hindsight provided by the Appellants’ specification, for one of skill in the art to select **a type** of surfactant from Sano for which there is no teaching in the prior art as to whether such surfactant type (when used in an amount required to have an effect) might negate the benefits of the inks described in the primary references. The Board has respectfully overlooked this issue in the Decision.

III. Sano Does Not Suggest the Improvements Shown in the Evidence of Record For the Claimed Ink Composition

In deciding that Appellants' evidence of non-obviousness is not persuasive because "improved results would have been expected for (the claimed) combination of surfactants/penetrants" (Decision at page 9, lines 6-21), the Board has respectfully misapprehended the following points:

(A) Sano describes the claimed penetrating agent as being particularly preferred only for the (alginate-containing) ink composition contained therein such that there would have been no expectation that it would improve results for other ink compositions; and

(B) even if the expectation of improved results extended to other ink compositions, the expectation would be that the claimed penetrant provides improvement with respect to penetration/balancing of properties (only); there would have been no expectation that the claimed penetrant would provide the claimed ink with the advantageous properties shown by the evidence of record (e.g., improved cohesion differential, gloss differential, glossiness, and ejection stability- -see Declaration of Kazuaki Watanabe filed 10 November 2003).

With respect to (A), Sano does **not** teach that the claimed penetrating agent is useful for inks other than those (alginate-containing) inks described therein. See Sano at column 8, line 62 to column 9, line 4 ("In order to provide the ink composition **of the present invention** with a necessary penetrating capacity. . . ." Emphasis added.); see, also, the passages cited in section I, *supra*.

With respect to (B), the Board has recognized in the Decision that the Sano penetrant is used (along with alginates) to effect a balancing or trade-off of properties (Decision at pages 6-7). This respectfully begs the question: why would one of skill in the art have expected that an improved penetration/balancing of properties would result in better cohesion differential, gloss differential, glossiness and ejection stability? Appellants respectfully submit that the Board has overlooked that one of skill in the art could **not** have expected **these** improvements, and that the unexpected nature of **these** improvements is what is determinative in the rebuttal of the alleged *prima facie* case. See, *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (holding that evidence that the claimed compound was unexpectedly nonaddictive was sufficient to overcome obviousness rejection, although the compound also had the expected result of potent analgesia.).

Moreover, the Board has respectfully also overlooked the evidence of record in the Watanabe Declaration that shows that the penetrant alone cannot impart these improved properties. In this respect, comparative Ink Set F described in the Declaration contains the claimed penetrant and all other components of the claimed ink composition except for the emulsion (see specification at page 32). Notwithstanding that this comparative ink composition contains the claimed penetrant, it does not possess the improvements in cohesion differential, gloss differential, glossiness, bronzing or fixing ability possessed by the claimed Ink Set A (see Declaration at table on page 3). Clearly, the improvement in the results shown in the Declaration is not due to, and could not have been expected from, the use of the penetrant alone, but is the result of the components in combination.

IV. The Decision Includes New Grounds of Rejection

In deciding that the evidence of unexpected results does not rebut the *prima facie* case of obviousness, the Board has also found that: (a) the cause and effect of the comparative testing is lost in the use of multiple variables (Decision at page 9, line 21 to page 10, line 10), and (b) the evidence is not commensurate in scope with the claims (Decision at page 10, lines 10-17). The Board has respectfully overlooked that these issues were not raised in the prosecution of this application or in the Examiner's Answer and thus constitute new ground(s) for rejection. See, *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (finding that raising for the first time on appeal the argument that showing of unexpected results is not commensurate in scope with the claims is in the nature of a new ground of rejection). Accordingly, it is respectfully considered that the new grounds should have been identified as such and Appellants should have been afforded an opportunity to respond in accordance with the provisions of 37 CFR 41.50(b) ("Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim.").

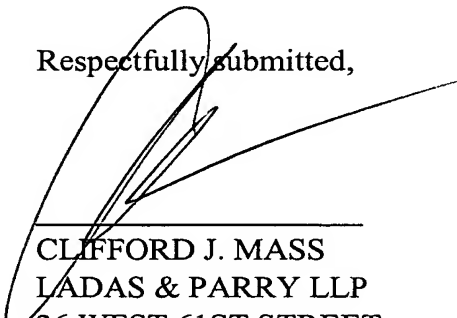
V. Conclusion

Upon rehearing, the decision of the examiner should be reversed, and the application should be allowed because there is no motivation to combine the cited references such that they

do not set forth a *prima facie* case of obviousness for the invention as claimed. Alternatively, if the Board still believes that the cited references set forth a *prima facie* case, the new grounds of rejection should be identified as such and Appellants should have the options afforded by the provisions of 37 CFR 41.50(b).

In any event, the Board should reverse its finding that the improved results of record would have been expected since this finding is a clear misapprehension of the teachings of the reference and the evidence in the Watanabe Declaration. Moreover, this finding might, if left unchanged, have an unjustifiably adverse effect on the further prosecution of this application under a "law of the case" doctrine should Appellants later submit additional evidence to rebut the alleged *prima facie* case.

Respectfully submitted,



CLIFFORD J. MASS
LADAS & PARRY LLP
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO.30,086(212)708-1890



AP
JFW

Practitioner's Docket

U 013698-2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kazuaki WATANABE, et al

Application No. 10/001,256

Group No.: 1755

Appeal No. 2005-1629

Filed: November 2, 2001

Examiner: Callie E. Shosho

For: INK COMPOSITION FOR INK JET PRINTER

BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

TRANSMITTAL

WARNING: Failure to file a complete response in compliance with § 1.135(c) leads to a reduction in patent term adjustment - See § 1.704(c)(7).

1. Transmitted herewith is a Request for Rehearing for this application.

STATUS

2. The application is qualified as
☐ a small entity.
☒ other than a small entity.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☒ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
37 C.F.R. 1.8(a)

37 C.F.R. 1.10*

- ☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"
Mailing Label No. _____ (mandatory)

TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office. to (703) 872-9306

Date: May 25, 2006

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run. " Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. § 1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

NOTE: 37 C.F.R. § 1.704(b)". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

(a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than <u>small entity</u>	Fee for <u>small entity</u>
<input type="checkbox"/>	one month	\$ 120.00	\$ 60.00
<input type="checkbox"/>	two months	\$ 450.00	\$ 225.00
<input type="checkbox"/>	three months	\$ 1,020.00	\$ 510.00
<input type="checkbox"/>	four months	\$ 1,590.00	\$ 795.00
<input type="checkbox"/>	five months	\$ 2,160.00	\$ 1,080.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

- (b) ☒ Applicant believes that no extension of term is required. However, this is a conditional petition being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1)	(Col. 2)	(Col. 3)	SMALL ENTITY	OTHER THAN A SMALL ENTITY
	Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra Rate	Addit. Fee	Addit. Fee
				<i>O</i>	<i>R</i>
Total	*	Minus	**	=	x \$ 25 \$
Indep.	*	Minus	***	=	x \$ 100 \$
<input type="checkbox"/> First Presentation of Multiple Dependent Claims				+ \$180=	\$
				Total Addit. Fee	\$ _____
				<i>O</i>	<i>R</i>
				Total Addit. Fee	\$ _____

- * If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,
 ** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".
 *** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
 The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) ☒ No additional fee for claims is required.

OR

- (d) ☐ Total additional fee for claims required \$ _____

FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ _____
☐ Charge Account No. 12-0425 the sum of \$ _____
 A duplicate of this transmittal is attached.

FEE DEFICIENCY OR OVERPAYMENT

NOTE: *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 12-0425.

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 12-0425

AND/OR

- ☒ Refund any overpayment to Account No. 12-0425.

Reg. No. 30086

Tel. No. 212-708-1890

SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry LLP
26 West 61 Street
New York, N.Y. 10023

Customer No.:



00140

PATENT TRADEMARK OFFICE